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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/033,067	10/26/2001	Roger Coleman	PF-0069-1 CON	7844
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27904 7590 12/17/2002

INCYTE GENOMICS, INC.  
3160 PORTER DRIVE  
PALO ALTO, CA 94304

EXAMINER

MERTZ, PREMA MARIA

ART UNIT

PAPER NUMBER

1646

DATE MAILED: 12/17/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
10/033,067

Applicant(s)  
Roger Coleman

Examiner  
Prema Mertz

Art Unit  
1646



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Oct 26, 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1, 3-16, 28, 29, 46, 47, and 57 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 1, 3-16, 28, 29, 46, 47, and 57 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

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## DETAILED ACTION

### *Election/Restriction*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group I. Claims 1, drawn to a human monocyte chemotactic proprotein, classified in Class 530, subclass 351.

Group II. Claims 3-7, 9-10, 12-13, 46, 57, drawn to a polynucleotide molecule encoding human monocyte chemotactic proprotein, a vector, a host cell, and a method of producing the polypeptide, classified in Class 435, subclass 69.5.

Group III. Claim 11, drawn to antibodies against the human monocyte chemotactic proprotein, classified in Class 530, subclass 387.1.

Group IV. Claim 8, drawn to a transgenic animal comprising a polynucleotide molecule encoding human monocyte chemotactic proprotein, classified in Class 800, subclass 21.

Group V. Claims 14-15, drawn to a method of detecting a target polynucleotide in a sample said target polynucleotide encoding human monocyte chemotactic proprotein by hybridizing a sample with a probe, classified in Class 435, subclass 6.

Group VI. Claim 16, drawn to a method of detecting a target polynucleotide in a sample said target polynucleotide encoding human monocyte chemotactic proprotein by amplifying said target polynucleotide, classified in Class 435, subclass 91.2.

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Group VII. Claim 28, drawn to a method of screening a compound for effectiveness in altering expression of a target polynucleotide said target polynucleotide encoding human monocyte chemotactic proprotein, classified in Class 435, subclass 7.1.

Group VIII. Claim 29, drawn to a method of assessing toxicity of a test compound, classified in Class 435, subclass 6.

Group IX. Claim 47, drawn to a method of generating an expression profile of a sample which contains polynucleotides, classified in Class 435, subclass 6.

The inventions are distinct, each from the other because of the following reasons:

Inventions I-IV are independent and distinct, each from the other, because they are products which possess characteristic differences in structure and function and each has an independent utility, that is distinct for each invention which cannot be exchanged. The nucleic acid of invention II can be used to make a hybridization probe or can be used in gene therapy as well as in the production of the protein of interest. The protein of invention I can be used as a probe, or used therapeutically or diagnostically, e.g. in screening. The antibody of invention III can be used to obtain the nucleic acid of Group II, and can also be used in diagnostics, e.g. as a probe in immunoassays. The transgenic animal of invention IV can be used in screening, to study the effect of drugs or the over expression of the human monocyte chemotactic proprotein

Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by

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another and materially different process (MPEP. § 806.05(f)). In the instant case the protein can be prepared by materially different processes, such as by chemical synthesis, or obtained from nature using various isolation and purification protocols.

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP. § 806.05(h)). In the instant case the product as claimed can be used as a hybridization probe.

Inventions II and V-IX are related as product and processes of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. § 806.05(h)). In the instant case the product of invention II can also be used in the production of the protein encoded by the polynucleotide.

Inventions I and V-IX are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation, or they have different functions, or they have different effects. (MPEP. § 806.04, MPEP. § 808.01). In the instant case the different inventions are not disclosed as capable of use together.

Inventions III and V-IX are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation, or they have

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different functions, or they have different effects. (MPEP. § 806.04, MPEP. § 808.01). In the instant case the different inventions are not disclosed as capable of use together.

Inventions IV and V-IX are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation, or they have different functions, or they have different effects. (MPEP. § 806.04, MPEP. § 808.01). In the instant case the different inventions are not disclosed as capable of use together.

Inventions V-IX are independent and distinct, each from the other, because the methods are practiced with materially different process steps for materially different purposes and each method requires a non-coextensive search because of different starting materials, process steps and goals.

Having shown that these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and recognized divergent subject matter as defined by MPEP. § 808.02, the Examiner has prima facie shown a serious burden of search (see MPEP. § 803). Therefore, an initial requirement of restriction for examination purposes as indicated is proper.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any

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amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

***Advisory Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Prema Mertz whose telephone number is (703) 308-4229. The examiner can normally be reached on Monday-Friday from 7:00AM to 3:30PM (Eastern time).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, can be reached on (703) 308-6564.

Official papers filed by fax should be directed to (703) 305-3014 or (703) 308-4242. Faxed draft or informal communications with the examiner should be directed to (703) 746-5300.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [yvonne.eyler@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark Office on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

*Prema Mertz*  
Prema Mertz Ph.D.  
Primary Examiner  
Art Unit 1646  
December 13, 2002